

PCT Rec'd 31 MAY 2001

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EL801566037US


Trudi Thompson

PATENT

Inventor: Iglesias
Int'l App'l No.: PCT/US97/15265 
Filed: 29 August 1997
Title: COMFORTABLE
ORTHOPAEDIC SUPPORT
AND THE METHOD OF
MAKING SAME
Atty Docket No.: 480032-213

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

RECEIVED

Attn: PCT Legal Staff
Box PCT
Assistant Commissioner for Patents
Washington, D.C. 20231

20 JUL 2001

Legal Staff
International Division

Sir:

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.494(b) or (c) or 1.495 (b) or (c) as applicable. The date of abandonment is the day after the date on which the 35 U.S.C. 371 (c) requirements were due. See 37 CFR 1.494(g) or 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

1. Petition Fee

Small Entity – fee \$ 620.00 (37 CFR § 1.17(m)). Applicant claims small entity status. See 37 CFR § 1.27.

Other than small entity – fee \$1,240.00 (37 CFR 1.17(m))

06/08/2001 MNNGUYEN 00000064 09857396

06 FC:241

620.00 0P

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of a _____ (identify type of reply).

has been filed previously on _____.

is enclosed herewith.

B. The Issue fee of \$ _____

has been paid previously on _____.

is enclosed herewith.

3. Terminal disclaimer with disclaimer fee

Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

A terminal disclaimer (and disclaimer fee (37 CFR 1.20 (d)) of \$ _____ for a small entity or \$ _____ for other than small entity) disclaiming a period equivalent to the period of abandonment is enclosed herewith.

4. Statement. The entire delay in filing the required reply from the due date of the required reply until the filing of a grantable petition under 37 CFR 1.137 (b) was unintentional.

5. Declarations. Declaration of Scott R. Hansen (with Exhibits 1-3) and Declaration of Johnny Thibeault (with Exhibit A) are filed herewith.



Scott R. Hansen
Registration No. 38,486

Dated: May 31, 2001

OPPENHEIMER WOLFF & DONNELLY LLP
2029 Century Park East, Suite 3800
Los Angeles, CA 90067
Telephone: (310) 788-5000
Facsimile: (310) 788-5100

Inventor: Iglesias et al.
International Application No. PCT/US97/15265
International Filing Date: 29 August 1997
Title: Comfortable Orthopaedic Support and the Method of Making the Same
US Application No.: <Application Filed Herewith>

DECLARATION OF SCOTT R. HANSEN IN SUPPORT OF
PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT

I, Scott R. Hansen, hereby declare as follows:

1. I am a member of Oppenheimer Wolff & Donnelly LLP. I am filing this Declaration in support of a Petition For Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b). The application became abandoned as to the United States because the fees and documents required by 35 USC 371(c) were not filed prior to the date that the documents were due.
2. On 29 August 1997, I filed International Application No. PCT/US97/15265, entitled "Comfortable Orthopaedic Support and the Method of Making the Same." (Exh. 1). The application claimed a Priority Date of 29 August 1996, based upon US Patent Application Serial No. 08/705,218 ("the '218 application"). For purposes of the US designation, the PCT application was a continuation-in-part of the '218 application, and contained new matter not previously disclosed in the '218 priority application. The new matter included Figures 16-21 and the new portions of the Specification corresponding thereto.
3. The 30-month deadline for entering the National Phase in the International Application was 29 February 1999. National Phase filings were made in Japan, the EPO,

Australia, and Canada, and all of those cases are currently pending. It was intended that a US national phase application would also be filed, as the Assignee is based in the United States. The Assignee, Royce Medical Company, actively sells in the United States a product that the patent application claims. (Exh. 2). The International Application explicitly stated that it was a "continuation-in-part" application, which only the United States recognizes, and the intention to file the case in the US was clear from the application itself. However, through inadvertance, a US national phase application was not filed prior to the abandonment of the PCT application for purposes of entering the US.

4. By way of background, the US priority application Serial No. 08/705,218 went abandoned on January 14, 1998 in favor of the present continuation-in-part that had been filed in the PCT, with a designation to the US. By mistake, formal drawings for the C-I-P PCT case were filed in the US priority case after the priority case had gone abandoned, by a registered US patent attorney who is no longer with the firm. (Exh. 3). The formal drawings were filed such that they were at the top of the file, so that the first papers seen upon review of the file were the formal drawings for the continuation-in-part.

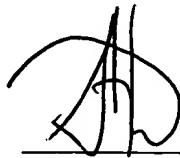
5. Upon inspecting the file, the undersigned saw that formal drawings corresponding to the C-I-P case had been filed with the Patent Office by the other attorney. The undersigned therefore believed the file to be that of a US national phase filing corresponding to the PCT continuation-in-part application, and that the other attorney who filed the drawings was handling the file. A US national phase case was therefore not filed at the same time that national phase filings were made in Japan, Canada, Australia and the European Patent Office. On April 13, 2001, while reviewing the status of the various national phase filings in this case, the undersigned first discovered that the PCT application had gone abandoned without a US national

phase application having been filed. The undersigned then immediately began preparing these papers and obtained signatures on the inventors' declaration from the inventors, one of whom is no longer with the Assignee and had to be located.

6. The Los Angeles office of Oppenheimer Wolff & Donnelly employs the widely-used CPI database in order to docket and monitor the many cases that it handles. (Declaration of Johnny Thibeault, filed herewith). When a US patent application is filed, regular dates are carefully and diligently docketed to remind the attorney to check on the status of the application. *Id.* However, in this case, because the priority case had already gone abandoned after the PCT application was filed, and because a subsequent US national phase application had not actually been filed, there was no status check or other date pertaining to the case in the docketing system. *Id.* The PTO also does not send out notices of abandonment in cases where there is no US national phase filing on a PCT application designating the United States. Consequently, there were neither dates on the firm's docket calendar nor a notice of abandonment from the Patent Office to alert the undersigned that a US national phase filing had not, in fact, been made.

7. The entire delay between the date that the PCT application became abandoned until the present was unintentional. Both the Assignee and the undersigned intended a US national phase application to be timely filed while the PCT application was pending. It is noted that MPEP Section 711.03(c) specifically contemplates reviving an application even though it has been abandoned for more than one year.

May 30, 2001
Date



Scott R. Hansen
USPTO Reg. No. 38,486

Inventor: Iglesias et al.
International Application No. PCT/US97/15265
International Filing Date: 29 August 1997
Title: Comfortable Orthopaedic Support and the Method of Making the Same
US Application No.: <Application Filed Herewith>

DECLARATION OF JOHNNY THIBEAULT

I, Johnny Thibeault, hereby declare as follows:

1. I am a Docket Clerk in the Docketing Department of the Los Angeles office of Oppenheimer Wolff & Donnelly LLP. I have approximately 9 years experience in intellectual property docketing.
2. The Los Angeles office of Oppenheimer Wolff & Donnelly employs the widely-used Computer Packages Incorporated (CPI) system in order to docket and monitor the many patent applications that it handles.
3. With respect to US Patent Application Serial No. 08/705,218, our docketing system calendared a date of 29 August 1997 as the one-year priority date in which to file foreign applications. (Printout From the CPI Database, Exh. A). Our system indicates that a Patent Cooperation Treaty application was filed on 29 August 1997. (Exh. A). A date of 28 February 1999 was calendared for the due date for entering the National Phase. The application entered the National Phase in Australia, Japan, Canada and the European Patent Office. (Exh. A). The priority US Patent Application Serial No. 08/705,218 had already gone abandoned by the National Phase due date.

4. Although the national phase deadline was docketed, there was not a separate docketing entry specifically reminding the attorney to file a national phase case in the United States. A memo reminding attorneys to separately docket US national phase filings from a PCT case has been circulated to attorneys in the Los Angeles office.

5. When a US patent application is filed, regular "status check" dates are docketed to remind the attorney to check on the status of the application if no papers are received for an extended period of time. However, when a case is abandoned, there are no further docket calendar entries for that case. Consequently, after the priority US application in this case went abandoned, there were no further status check or other reminders to the attorney.

5/29/81
Date


Johnny Thibeault

09/857396

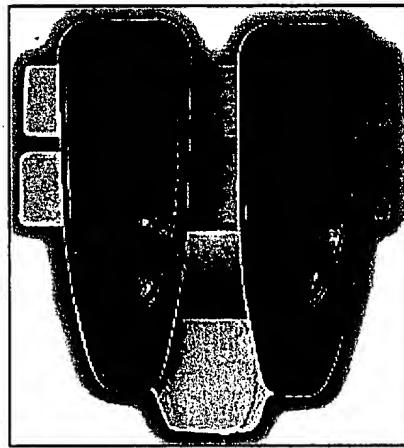
JG18 Rec'd PCT/PTO 31 MAY 2001

Equalizer Premium
WalkersFormFit Braces
& SupportsTechForm Casting
SuppliesDiabetic Footcare
ProductsUpper Extremity
ProductsLower Extremity
ProductsReturn to
Catalog Home**ANKLE STIRRUPS****ROYCE MEDICAL**

F O R M F I T

**FORMFIT ANKLE
STIRRUP WITH
HONEYCOMB PADS**

**Formfit Stirrup Ankle
Braces with
Revolutionary "Flex
Edge" Technology**



- **FLEX EDGE FEATURE** Patented overmold technology incorporates a soft flexible edge onto the hard outer shell. Effectively eliminates pressure points on the ankle and increases comfort to your patient.
- **PIVOTING HEEL STRAPS** New straps allow for unobstructed range of motion in plantar and dorsiflexion. Quick-adjusted heel loop allows for a custom fit even after the brace is on the patient.
- Honeycomb pads offer varying comfort zones while contouring to the anatomy. Aeration holes provide breathability.
- Built-in comfort zones provide varying levels of compression and support.
- Aeration holes ensure a cool and breathable pad surface.

Item #	Description
30100	FormFit Ankle Stirrup, with Honeycomb pads, Left
30101	FormFit Ankle Stirrup, with Honeycomb pads, Right

Please Note: Royce Medical Company accepts orders only from medical professionals and their staff. If you are a patient or a consumer please consult your medical provider

Protected by U.S. Patents 4,844,094; 4,913,755; Re 35,113; 5,334,135; 5,445,602; 5,695,452; 5,716,335. Other U.S. and foreign patents pending.

800-521-0601

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Country Applications

29-May-2001

Client Matter:	480032-000213	Family Number:	118-178
Country:	WO	Patent Cooperation Treaty	
Client: ROYCE MEDICAL COMPANY			
Case Type:	ORD	Application Status:	PENDING
Application Number:	97/15265	Filing Date:	29-Aug-1997
Patent Number:		Issue Date:	
Publication Number:		Publication Date:	
Tax Schedule:		Expiration Date:	
Allowed Date:		Priority Date:	29-Aug-1996
Attorney:			
Agent:			

Agent Reference Number: Client Matter: 480032-000213 WO

All Actions Due	Due Date	Indicator	Date Taken
1MO RMDR-SEARCH REPORT	10-Dec-1997	Reminder	05-Dec-1997 <input checked="" type="checkbox"/>
AMEND RE SEARCH REPROT	10-Jan-1998	Due Date	09-Jan-1998 <input checked="" type="checkbox"/>
3MO-WITHDRAWAL	29-Jan-1998	Reminder	22-Jan-1998 <input checked="" type="checkbox"/>
2 MO REM DEMAND	29-Jan-1998	Reminder	28-Jan-1998 <input checked="" type="checkbox"/>
RMDR DEMAND DUE	12-Feb-1998	Reminder	12-Feb-1998 <input checked="" type="checkbox"/>
2 MO REM NATL	28-Feb-1998	Reminder	26-Feb-1998 <input checked="" type="checkbox"/>
1MO RMDR-DEMAND DUE	28-Feb-1998	Reminder	26-Feb-1998 <input checked="" type="checkbox"/>
Demand Due	29-Mar-1998	Due Date	29-Mar-1998 <input checked="" type="checkbox"/>
National	29-Apr-1998	Due Date	29-Apr-1998 <input checked="" type="checkbox"/>
WITHDRAWAL?	29-Apr-1998	Due Date	22-May-1998 <input checked="" type="checkbox"/>
2WK RMDR-CORRECT DEFECTS	07-May-1998	Reminder	26-May-1998 <input checked="" type="checkbox"/>
CORRECT DEFECTS IN DEMAND	21-May-1998	Due Date	26-May-1998 <input checked="" type="checkbox"/>
Action Chk:	09-Jul-1998	Due Date	09-Jul-1998 <input checked="" type="checkbox"/>
1MO RMDR-WRITTEN OPINION	02-Aug-1998	Reminder	12-Aug-1998 <input checked="" type="checkbox"/>
2WK RMDR-WRITTEN OPINION	19-Aug-1998	Reminder	02-Sep-1998 <input checked="" type="checkbox"/>
AMEND RE WRITTEN OPINION	02-Sep-1998	Due Date	02-Sep-1998 <input checked="" type="checkbox"/>
PRIORITY CLAIM Follow Up Date	22-Nov-1998	Due Date	24-Jul-1998 <input checked="" type="checkbox"/>
2 MO REM NATLII	29-Dec-1998	Reminder	29-Dec-1998 <input checked="" type="checkbox"/>
2MO-WITHDRAWAL	29-Dec-1998	Reminder	22-May-1998 <input checked="" type="checkbox"/>
Natn'l II	28-Feb-1999	Due Date	22-Feb-1998 <input checked="" type="checkbox"/>
WITHDRAWAL?	28-Feb-1999	Due Date	22-May-1998 <input checked="" type="checkbox"/>
2WK RMDR-FILE EPO	14-Mar-1999	Reminder	28-Mar-1999 <input checked="" type="checkbox"/>
ELECT TO FILE IN EPO	28-Mar-1999	Due Date	28-Mar-1999 <input checked="" type="checkbox"/>

Invention Data

Client-Matter:	480032	000213	Family Number:	118-178
Client:	ROYCE MEDICAL COMPANY			P.S. Code:
Client Reference:				Laid Open Date:
Attorney:	SRH	ACR	SC	Disclosure Status: Open
Owner:				
Title:	COMFORTABLE ORTHOPEDIC SUPPORT AND THE METHOD OF MAKING THE SAME			
Priority Country:				
Assign Executed:	28-Aug-1996			
Recorded Date:	29-Aug-1996			
Reel:	8164			
Frame:	857-86			
Inventors				
INGLESIS, JOSEPH M.				
JOHNSON, ERIC E.				
GRIM, TRACY E.				
ARNOLD, WILLIAM K.				

Country Applications:

Client Matter: 480032-000213

Ctry	Sub	Case	Type	Status	Application Number	Filing Date	Patent Number	Issue Date	
WO		ORD	PENDING		97/15265	29-Aug-1997			
US		ORD	Abandone		08/705,218	29-Aug-1996			 
CA		ORD	PENDING		2264656	29-Aug-1997			
AU		ORD	PENDING		41713/97	29-Aug-1997			
JP		ORD	Published		511973/98	29-Aug-1997			 
EP		PCT	Published		97939681.9	29-Aug-1997			

Keywords: 1: COMFORTABLE 2: ANKLE

Remarks:

OPENED 4/3/96

User ID: daemeon	Date Created: 17-Mar-1997	Last Update: 10-Oct-2000
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Country Applications

29-May-2001

Client Matter:	480032-000213	Family Number:	118-178
Country:	JP	Japan	SubCase:
Client: ROYCE MEDICAL COMPANY			
Case Type:	ORD	Application Status:	Published
Application Number:	511973/98	Filing Date:	29-Aug-1997
Patent Number:		Issue Date:	
Publication Number:	217217	Publication Date:	26-Dec-2000
Tax Schedule:		Expiration Date:	
Allowed Date:		Priority Date:	29-Aug-1996
Attorney:			
Agent:			

Agent Reference Number:

Client Matter: 480032-000213 JP

All Actions Due	Due Date	Indicator	Date Taken	
Status Check--Foreign Appln	19-Jul-2001	Courtesy		<input checked="" type="checkbox"/>
1YR RMDR-REQ.EXAM	29-Aug-2003	Reminder		<input checked="" type="checkbox"/>
REQUEST EXAM	29-Aug-2004	Due Date		<input checked="" type="checkbox"/>
Deferred Exam	29-Aug-2004		29-Jan-2001	<input checked="" type="checkbox"/>

Country Applications

29-May-2001

Client Matter:	480032-000213	Family Number:	118-178
Country:	CA	Canada	SubCase:
Client:	ROYCE MEDICAL COMPANY		
Case Type:	ORD	Application Status:	PENDING
Application Number:	2264656	Filing Date:	29-Aug-1997
Patent Number:			
Publication Number:			
Tax Schedule:			
Allowed Date:			
Attorney:			
Agent:			

Agent Reference Number:

Client Matter: 480032-000213 CA

All Actions Due	Due Date	Indicator	Date Taken	
Deferred Exam	29-Aug-1997		03-Jan-2000	<input checked="" type="checkbox"/>
TAX DUE	29-Aug-1999	Due Date	24-Jun-1999	<input checked="" type="checkbox"/>
3MO RMDR-RESPONSE DUE	26-Nov-1999	Reminder	26-Nov-1999	<input checked="" type="checkbox"/>
1MO RMDR-RESPONSE DUE	26-Jan-2000	Reminder	26-Jan-2000	<input checked="" type="checkbox"/>
RESPONSE DUE	26-Feb-2000	Due Date	25-Feb-2000	<input checked="" type="checkbox"/>
TAX DUE-1MO REM	29-Jul-2001	Reminder		<input checked="" type="checkbox"/>
TAX DUE	29-Aug-2001	Due Date		<input checked="" type="checkbox"/>
1YR RMDR-REQUEST EXAM	29-Aug-2001	Reminder		<input checked="" type="checkbox"/>
TAX DUE-FINAL	28-Feb-2002	Final		<input checked="" type="checkbox"/>
REQUEST EXAM	29-Aug-2002	Due Date		<input checked="" type="checkbox"/>

Country Applications

29-May-2001

Client Matter:	480032-000213	Family Number:	118-178
Country:	AU	Australia	SubCase:
Client:	ROYCE MEDICAL COMPANY		
Case Type:	ORD	Application Status:	PENDING
Application Number:	41713/97	Filing Date:	29-Aug-1997
Patent Number:		Issue Date:	
Publication Number:		Publication Date:	
Tax Schedule:		Expiration Date:	
Allowed Date:		Priority Date:	29-Aug-1996
Attorney:			
Agent:			

Agent Reference Number:

Client Matter: 480032-000213 AU

All Actions Due	Due Date	Indicator	Date Taken
3MO RMDR-REQUEST EXAM	30-Jun-1999	Reminder	30-Jun-1999
2MO RMDR-REQUEST EXAM	31-Jul-1999	Reminder	31-Jul-1999
1MO RMDR-REQ EXAM	30-Aug-1999	Reminder	30-Aug-1999
REQUEST EXAM	30-Sep-1999	Due Date	10-Jun-1999
RESPONSE DUE	08-Feb-2001	Due Date	
RESPONSE DUE	08-Mar-2001	Due Date	
1 YR RMNDR - REQUEST EXAM	29-Aug-2001	Reminder	07-Apr-1999
ACCEPTANCE DATE-2MO	08-Sep-2001	Reminder	
ACCEPTANCE DATE-1MO	08-Oct-2001	Reminder	
ACCEPTANCE DATE-FINAL	08-Nov-2001	Final	
TAX DUE-1MO REM	29-Jul-2002	Reminder	
TAX DUE	29-Aug-2002	Due Date	
REQUEST EXAM	29-Aug-2002	Due Date	07-Apr-1999
Deferred Exam	29-Aug-2002		14-Dec-2000
TAX DUE-FINAL	28-Feb-2003	Final	

Country Applications

29-May-2001

Client Matter:	480032-000213	Family Number:	118-178
Country:	EP	European Patent Office	SubCase:
Client:	ROYCE MEDICAL COMPANY		
Case Type:	PCT	Application Status:	Published
Application Number:	97939681.9	Filing Date:	29-Aug-1997
Patent Number:		Issue Date:	
Publication Number:		Publication Date:	14-Jun-2000
Tax Schedule:		Expiration Date:	
Allowed Date:		Priority Date:	29-Aug-1996
Attorney:	ACR	ALAN ROSE	
Agent:	LEW	LEWIS & TAYLOR	

Agent Reference Number: P5482EP

Client Matter: 480032-000213 EP

All Actions Due	Due Date	Indicator	Date Taken
TAX DUE	29-Aug-1999	Due Date	29-Aug-1999
TAX DUE (EXT)	29-Sep-1999	Due Date	02-Nov-1999
TAX DUE (FINAL EXT)	28-Feb-2000	Due Date	02-Nov-1999
1 MO REM - FILE IN HK	14-Nov-2000	Reminder	17-Nov-2000
FILE IN HK	14-Dec-2000	Due Date	17-Nov-2000
Exam Fee	14-Dec-2000	Due Date	14-Dec-2000
TAX DUE - EXT	28-Feb-2001	Due Date	
1 MNTH REM-RESPONSE UE	14-May-2001	Reminder	
FILE IN HK Follow Up Date	17-May-2001	Due Date	17-Nov-2000
RESPONSE DUE	14-Jun-2001	Due Date	
Status Check--Foreign Appln	27-Jun-2001	Courtesy	09-Mar-2001
TAX DUE-1MO REM	29-Jul-2001	Reminder	
TAX DUE	29-Aug-2001	Due Date	
TAX DUE-FINAL	28-Feb-2002	Final	

Country Applications

29-May-2001

Client Matter:	480032-000213	Family Number:	118-178
Country:	US	United States of America	SubCase:
Client:	ROYCE MEDICAL COMPANY		
Case Type:	ORD	Application Status:	Abandoned
Application Number:	08/705,218	Filing Date:	29-Aug-1996
Patent Number:			
Publication Number:			
Tax Schedule:	SE	Issue Date:	
Allowed Date:	14-Oct-1997	Publication Date:	14-Oct-1997
Attorney:			
Agent:			
Agent Reference Number:			
Client Matter:	480032-000213	US	
All Actions Due	Due Date	Indicator	Date Taken

User ID:	LUIS	Date Created:	23-Oct-1997	Last Update:	22-Dec-1998
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